SUPREME COURT, U. S.

FILED
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JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1968.

No. 1355.

BLUMCRAFT OF PITTSBURGH,
a Partnership Consisting of
Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,
Petitioners,

v.

CITIZENS AND SOUTHERN NATIONAL BANK
OF SOUTH CAROLINA,
DANIEL CONSTRUCTION COMPANY, INC.
and COLONIAL IRON WORKS, INC.,
Respondents.

REPLY BRIEF AND APPENDIX FOR PETITIONERS IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT.

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Introduction.

In their brief in opposition to the petition for writ of certiorari, Respondents first recite a series of supposed "real questions for consideration" and then elsewhere (p. 18) dismiss them with the pronouncement that "the only real question here presented is whether the right decision was reached under the evidence presented by Respondents". The candid observation at page 18 should be corrected to state that "the only question here presented is *which court* reached the right decision under the evidence presented by Respondents."

Respondents' attack on the petition devolves into the following contentions:

(a) The Court of Claims' decision, not being an "appeal" and based upon a different record, is not in conflict with the present case.

(b) The doctrine of comity does not oblige the Court of Appeals to follow blindly the decision of a coordinate court.

(c) There is no relation between the *Pavement Salvage* case and the present case.

(d) It was proper for the Court of Appeals to decide the case *de novo* despite the findings of the District Court.

(e) Petitioners merely seek redress for the errors of the Court of Appeals and there is no significance beyond this case.

Of these points:

(a) is incorrect and based on false premises,

(b) is true but irrelevant to this case,

(c) is incorrect,

(d) is in direct conflict with the most recent decision of the Supreme Court in a patent case, *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 161 U. S. P. Q. No. 7 Supp. pp. 1-15 (May 19, 1969) and

(e) is incorrect—the conflict will extend to other cases in other courts involving the same patents unless decided by the Supreme Court.

There Is a "Real and Embarrassing Conflict of Opinion and Authority" Between the Court of Appeals for the Fourth Circuit and the Court of Claims.

(a) The Record Based on the Prior Art Is the Same in Both Cases—Respondents Are in Error.

Respondents, in conceding that certiorari should be granted in a case involving a direct conflict between a decision of the Court of Claims and the Court of Appeals pursuant to Rule 19 of the Supreme Court Rules, argue that there is no real conflict here because "less than half of the prior art cited by Respondents in this case against the design patent was brought to the attention of the Trial Commissioner" and "of the seven specific prior art references referred to in the opinion of the Court of Appeals as being important . . . only four were of record as prior art in the Court of Claims action". They specifically assert that the Hollaender stair rail, the W. T. Grant store rail (Architectural Record, July, 1934) and the Sanitorium rail (Architectural Record, March, 1940), were not brought to the attention of the Commissioner in the Court of Claims and this was "an important reason why the Court of Appeals reached a conclusion on the validity of the design patent different from that . . . of the Court of Claims". (Brief for Respondents, p. 15).

Respondents are completely wrong on the facts. First, all of the prior art patents and published architectural ref-

erences in the present case and the Hollaender and Home Federal Savings and Loan Building railings were brought to the attention of the Trial Commissioner in the Court of Claims. The notices of prior art in both cases establishing this fact are presented in the Appendixx, pages 75a-87a. It will be noted that the Trial Commissioner was informed in each instance. Second, each of the specific items of prior art—Hollaender, W. T. Grant and the Sanitorium railing—was paired by the Court of Appeals for the Fourth Circuit in its own opinion with a second reference as showing the identical subject matter (Appendix, 43a-49a). In each case the second reference was not only brought to the attention of the Trial Commissioner in the Court of Claims case but was actually referred to in the Court of Claims opinion (Appendix, 70a):

Prior Art Specified by Respondents	*Second Identical Reference*	*Court of Claims Exhibit Number*
Hollaender	Wallach's Jamaica Store	Defendant's Exhibit 6
W. T. Grant	Kansas City Auditorium	Defendant's Exhibit 1
Sanitorium	Saarinen Church	Defendant's Exhibit 3

It is clear that Respondents are wrong in their contention that there was any difference in the prior art before the Court of Appeals for the Fourth Circuit and that cited in the Court of Claims.

(b) The Decision of the Court of Claims Was the Final Adjudication of That Court.

Respondents' second reason for urging the Court to disregard the confiict between the Court of Appeals for

the Fourth Circuit and the Court of Claims is that "there is no appeal involved in the Court of Claims suit" (Brief for Respondents, p. 15). The Respondents appear to misunderstand the procedure of the Court of Claims. There is *never* an appeal in such cases within the Court of Claims.

Stern and Grossman, Supreme Court Practice, Section 4-7 (3rd ed.):

> "Where there is a direct conflict between a decision of a Federal Court of Appeals and that of the United States Court of Claims, there is ground for Supreme Court review of either decision by way of certiorari. While the Court of Claims is a court of first instance, its decisions are final within the realm of its jurisdiction, subject only to review by the Supreme Court. In this respect, therefore, the decisions of the Court of Claims are like those of Courts of Appeals. Since conflicts between them can be resolved only by the Supreme Court, certiorari is granted in such cases."

The *Blumcraft* case was adjudicated entirely in accordance with the procedures set forth in the pertinent Court of Claims Rules. The case was referred to the Commissioner under Rule 43. He acted as the "trial judge" of the Court of Claims pursuant to Rule 52, heard evidence presented during one week of trial and submitted his report to the Court one year later in accordance with Rules 54-57.[1] The Court then proceeded in accordance with Rules 62 and 65 relating to the submission of cases without exception by

1. Notwithstanding Respondents remark that the Justice Department assigned the case to a "junior attorney", every defense in the present case was presented by the Justice Department in the Court of Claims with the full cooperation and assistance of Respondents' attorney who attended the entire trial at the expense of Architectural Art but ostensibly not on their "behalf" (Appendix, 87a).

either party to find the facts, state the conclusions of law and direct the entry of judgment in accordance with Rule 66. The case had been fully briefed by the parties and recommended findings of fact and conclusions of law and objections were submitted in accordance with Rule 57 and are included in the record of the Court. As set forth in the petition for certiorari, an agreement was reached with respect to the accounting in which the Government specified that the agreement related to the accounting procedure only and did not represent final disposition of the case at that time. The accounting is still in process and includes, among others, the products of Architectural Art.[2] The Trial Commissioner in the Blumcraft case was Commissioner Donald E. Lane who was the Trial Commissioner in *United States v. Adams,* 383 U. S. 1 (1966) in which case, as in the present case, his report was adopted by the full Court of Claims, and was affirmed by the Supreme Court on certiorari.

In holding Louis Blum's patent invalid the Court of Appeals for the Fourth Circuit itself acknowledged that its ruling was in direct conflict with the Court of Claims (Appendix, 48a): "The Court of Claims recently found Blum's design patent valid."

The Rules of the Supreme Court provide, and Respondents do not argue to the contrary, that conflict between the Court of Claims and the Court of Appeals calls for the exercise of the review power of the Supreme Court. The conflict in this case is "real and embarrassing" and can only

2. The actions of Architectuarl Art continue to belie the arguments now presented to the Court. While arguing here that there is no relation between the Court of Claims case and the present case, Architectural Art, through its President, has argued to the Court of Claims in the accounting procedure in a motion dated February 27, 1969 that it should not be compelled to respond to a subpoena duces tecum "in view of the decision of the U. S. Court of Appeals for the Fourth Circuit on February 19, 1969, holding design patent D-171,963 invalid and unenforceable against Architectural Art Mfg., Inc.". (Appendix, 95a-98a).

be resolved in this Court. *N. L. R. B. v. Pittsburgh S. C. Co.*, 340 U. S. 499, 502 (1951).

Respondents Misstate the Doctrine of Comity as Presented by Petitioner.

In their Brief, Respondents misstate the doctrine of comity as presented by Petitioners:

> "Blumcraft, citing *Mast, Foos & Company v. Stover Manufacturing Company*, 177 U. S. 485 (1900), contends that under the doctrine of judicial comity, it was error for the Court of Appeals to reach an independent conclusion on the validity of the design patent, since the Court of Claims had previously held the patent valid." (Brief for Respondents, p. 11)

This, of course, is not Petitioner's contention at all. Petitioners rely only upon the rule of comity applied in the dozen or more cases cited in the petition and as succinctly stated by the Supreme Court in the *Mast, Foos* case, p. 489:

> "It demands . . . that deference shall be paid to the judgments of other coordinate tribunals".

The error of the Court of Appeals for the Fourth Circuit was not in reaching an independent conclusion but in failing to give that deference to the prior decision of the Court of Claims which even the Respondents concede is required by the *Mast, Foos* decision. Since the Court of Appeals failed to pay any attention whatever to the decision of the Court of Claims, the Supreme Court must determine itself whether the decision of the Court of Appeals for the Fourth Circuit was indeed "correct upon the merits" as provided in the *Mast, Foos* decision, *supra* at page 489 and this can only be done by granting the writ of certiorari.

Respondents insist that nothing can be gained "merely to reiterate the law of comity as set down by this Court in *Mast, Foos & Company v. Stover Manufacturing Company, supra.*" They overlook the current burden of litigation upon the Federal Courts and the need for a more uniform administration of justice in the field of patents evidenced by the many recent decisions cited in the petition.

This is a proper time for the Court to develop the doctrine of comity so as to limit the endless relitigation of the validity of a single patent in each of the Courts, producing contrary results on the same record.

The Conflict With *Pavement Salvage Co. v. Anderson's-Black Rock, Inc.* Presents a Separate Basis for Granting Certiorari.

Respondents challenge Petitioner's reliance upon the conflict between different panels of the Court of Appeals for the Fourth Circuit as a "novel . . . theory". This is not so. Conflict within a single Circuit is, in itself, an accepted basis for the grant of the writ of certiorari, *John Hancock Mutual Life Insurance Co. v. Bartels,* 308 U. S. 180 (1939), *Dickinson v. Petroleum Conversion Corp.,* 338 U. S. 507 (1950), *Maggio v. Zeitz, Trustee in Bankruptcy,* 333 U. S. 56 (1948).

Respondents cannot be serious in their further contention that "there is no relationship whatsoever" between this case and *Pavement Salvage Co. v. Anderson's-Black Rock, Inc.,* 404 F. 2d 450 (1968), "other than the fact that both cases involve patents". They concede that the present case presents a question of "obviousness" under § 103 of the Patent Act in the light of the decision of the Court in *Graham v. John Deere Co.,* 383 U. S. 1 (1966). In the *Pavement Salvage* case, the Court of Appeals stated precisely the same question (at p. 452):

> "The question, then, is whether the solution 'would have been obvious at the time the invention was made to a person having ordinary skill in the art * * *' within the meaning of 35 U. S. C. A. § 103, as interpreted in Graham v. John Deere Co., 383 U. S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545."

The Court then cited *Blumcraft of Pittsburgh v. United States,* 372 F. 2d 178 (1967) 1014 Ct. Cl. 798, among others, as authority for its construction of § 103 of the Patent Act. The petition for writ of certiorari in the *Pavement Salvage* case specifically refers to § 103 of the Patent Act as the pertinent statutory provision. Throughout both the petition and the Respondents' brief it is insisted that the question before the Court is the application of § 103 by the Court of Appeals in light of the Supreme Court's decision in *Graham v. John Deere Co., supra.* Of course the specific facts and the patents in this case are different from those in *Pavement Salvage.* Both cases, however, involve the application of § 103 of the Patent Act and the determination of "obviousness."

Certainly the relationship between the present case and the *Pavement Salvage* case is far closer than the relationship between *Graham v. John Deere Co., Calmar, Inc. v. Cooke Chemical, Inc.* and *United States v. Adams,* 383 U. S. 1 (1966), all heard together and decided together by the Court. In those cases the only common element was the construction of § 103. In the present case we also have the demonstrated conflict within the Court of Appeals for the Fourth Circuit as to the decision by the Court of Claims in *Blumcraft of Pittsburgh v. United States, supra.*

Respondents seem to invite certiorari in this case by flatly asserting that "the Graham guidelines in their entireties were applied by *both* panels in reaching the final

conclusions'' (emphasis added). If in both cases the Court of Appeals undertook to apply the principles enunciated by the Supreme Court in *Graham v. John Deere Co.* but arrived at opposite results and the Court has granted certiorari in the *Pavement Salvage* case, then it would seem that the Court should grant certiorari *per force* in the present case.

New and Separate Reason for Granting the Writ of Certiorari: The Decision of the Court of Appeals for the Fourth Circuit Is in Conflict With the Decision of the Court in *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 161 U. S. P. Q. No. 7, Supp. pp. 1-15 (May 19, 1969).

Beyond acknowledging the decision of the District Court at page 7 of their brief, Respondents make no reference whatever to the opinion of the District Court in this case or its findings of fact. Respondents refer solely to the findings and conclusions of the Court of Appeals, treating the hearing in that Court as a trial *de novo*. Respondents in their brief state that the Court of Appeals made its own determination on the evidence:

> ''the Court of Appeals below on its own determination held the design patent in suit invalid . . .'' (Page 10)
>
> ''the Court of Appeals . . . [made] conclusive determinations on each of the primary tests . . .'' (Page 13)
>
> ''Respondents submitted all pertinent evidence in the proceedings below and demonstrated conclusively to the Fourth Circuit Court of Appeals that the design patent should be held invalid.'' (Page 15)
>
> ''the Court of Appeals reached a conclusion on the validity of the design patent different from that of the

> Trial Commissioner of the Court of Claims . . ." (Page 15)
>
> "However, after giving these secondary matters all the weight to which they were entitled in light of the evidence, the Court [of Appeals] concluded . . ." (Page 18)

The candid remarks in Respondents' brief affirm what is evident from the opinion of the Court of Appeals: virtually no consideration was given to the testimony of the witnesses at the trial, the entire body of prior art presented at the trial or the findings of fact of the District Court. The Court of Appeals "on its own determination" held the design patent in suit invalid on the basis of a selected few of the prior art references and its own opinion.

As in the case of the doctrine of comity, the Court of Appeals is not bound to accept any other Court's determination but also as in the case of the doctrine of comity, the Court of Appeals is bound to pay deference to the findings of fact of the District Court.

This is not a case where the Court of Appeals examined the findings of the District Court in light of the evidence and found them erroneous. Many key Findings of Fact were not even mentioned by the Court of Appeals as is demonstrated in the chart set forth in the Appendix, 89a-94a. The Court of Appeals simply ignored the extensive findings of fact and, indeed, from its opinion it hardly appears that there was a trial of the case or the presentation of any testimony but only the patents in suit and the prior art references selected for argument by Respondents. This sterile analysis exemplifies the type of paper examination normally employed in *ex parte* proceedings in the Patent Office. When evidence presented at the trial and the findings of fact are ignored, it is as easy to decide a case one way as another and to hold a patent valid as invalid.

In *Zenith Radio Corp. v. Hazeltine Research, Inc.*, *supra* (decided after the filing of the Petition herein), the Court reversed the decision of the Court of Appeals, which in turn had reversed the District Court, for the reason that the Court of Appeals had arrived at its own conclusion on the evidence but had failed to give the deference to the findings of the trial court required by Rule 52(a) of the Federal Rules of Civil Procedure. At pages 7-8 the Court said:

> "In applying the clearly erroneous standard to the findings of a district court sitting without a jury, appellate courts must constantly have in mind that their function is not to decide factual issues *de novo*. The authority of an appellate court, when reviewing the findings of a judge as well as those of a jury, is circumscribed by the deference it must give to decisions of the trier of the fact, who is usually in a superior position to appraise and weigh the evidence. The question for the appellate court under Rule 52(a) is not whether it would have made the findings the trial court did, but whether 'on the entire evidence [it] is left with the definite and firm conviction that a mistake has been committed.' *United States v. United States Gypsum Co.*, 333 U. S. 364, 395 (1948). See also *United States v. National Assn. of Real Estate Boards*, 339 U. S. 485, 495-496 (1950), *Commissioner v. Duberstein*, 363 U. S. 278, 289-291 (1960)."

In the present case the Court of Appeals did not expressly reverse a single one of the District Court's findings of fact as clearly erroneous but simply dismissed them or ignored them altogether and made its own determination that Louis Blum's design patent was invalid. The failure of the Court of Appeals to give any deference to the findings of fact of the District Court and the arrogation to itself of the fact finding power conflicts with the established judi-

cial decision-making process and with the decisions of the Supreme Court, particularly *Zenith v. Hazeltine, supra,* and is thus a proper case for review by the Court.

Certiorari Should Be Granted to Prevent Further Judicial Confusion.

Respondents suggest that certiorari is sought by Petitioners merely to obtain further review of the errors of the Court of Appeals in this case. Granted, the District Court opinion graphically portrays the injustice of the deliberate piracy of Louis Blum's inventions permitted by the decision appealed from. But the validity of the patent has already been affirmed by one court—the United States Court of Claims. There can be no question that some injustice has been done—both Courts cannot be right.

The question is what will be the result when the patents are litigated in other courts. The patents are in issue presently in the District of Kansas and it is expected that the Court will follow the result in this case. The design patent expired in 1968 so that litigation involving that patent is possible during the next five years. The mechanical patent does not expire until 1975. The record in this case established that several manufacturers sought to copy Louis Blum's design. Infringements of both patents are presently being investigated and the prospect of further litigation is real.

Unless the validity of the patents is settled by the Supreme Court any lower court will be free to hold them valid or invalid. The precedent for such further conflicting results is established by the decision of the Court of Appeals for the Fourth Circuit in this case. The result, inevitably, will be more "real and embarrassing" conflicts of authority. The present circumstances call for the grant of certiorari to end the confusion produced by the present conflict of authority.

Conclusion.

Architectural Art Mfg., Inc.—the hidden defendant in both the Court of Claims and Fourth Circuit cases—seeks the unlimited right to relitigate the validity of Louis Blum's patent until it is held invalid.

Architectural Art is quick to deny its direct involvement in either the Court of Claims case or the present case (Brief for Respondents, page 5) but is equally quick to claim the benefits of whatever transpires in either action. In fact, Architectural Art has lurked in the background of both of these cases without ever being caught as a party. While Louis Blum's design patent was being litigated in the Court of Claims, Architectural Art's attorney, deliberately concealing his activities, was in direct collaboration with the Justice Department in the presentation of the attack on the patent.[3] When that attack failed, both before the Commissioner and the full Court of Claims, Architectural Art presented the same attack against the design patent, based upon the same prior art, in the District Court for the District of South Carolina. Failing there, Architectural Art finally obtained a ruling reversing the District Court and sustaining its attack on the patent from one panel of the Court of Appeals for the Fourth Circuit. It is difficult to imagine a case demonstrating more vividly the value of the doctrine of comity

3. Respondents seriously understate their involvement with the Government in the Court of Claims case. Far from merely identifying prior art on request, Architectural Art's attorney, over a period of more than a year involving numerous letters, telephone conversations and meetings, solicited and received the help of the Justice Department in this case and secretly supplied the Justice Department with depositions from this case for use in the Court of Claims. He urged secrecy on the Justice Department attorney to "avoid any necessity of your referring to direct collaboration with us in this suit which we prefer". (Letter from Warren N. Williams, Esquire to Department of Justice, August 13, 1964, Appendix, 99a).

to reduce needless multiple litigation of a patent's validity in several courts.

This case presents a direct conflict among and between Federal Courts and important questions of judicial administration in the field of patents which require decision by this Court. The years which have passed since the decision in *Graham v. John Deere Co.,* the more than seventy-five years which have passed since the Court has considered a design patent and the conflicts which are presented in this case, warrant the attention of the Court at this time.

Respectfully submitted,

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IN THE

UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF SOUTH CAROLINA.

CIVIL ACTION NO. 4168.

BLUMCRAFT OF PITTSBURGH, A PARTNERSHIP CONSISTING OF HYMAN BLUM, MAX BLUM, LOUIS BLUM AND HARRY P. BLUM,

Plaintiff,

v.

CITIZENS & SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, AND DANIEL CONSTRUCTION COMPANY, INC.,

Defendants.

NOTICE UNDER TITLE 35, UNITED STATES CODE, SECTION 282.

NOW COME THE DEFENDANTS, and in accordance with the provisions of Title 35, United States Code, Section 282, give notice that, at the trial of this action, the following patents, publications and prior use and knowledge will be relied upon as anticipation of the respective patents in suit and showing the state of the art pertinent thereto:

As to U. S. Design Letters Patent No. 171,963;

U. S. Letters Patent No. 1,864,160
Issued June 21, 1932 to R. G. Williams

Architectural Record
April 1933, Page 269

Architectural Record
July 1934, Page 19

Architectural Forum
March 1937, Pages 219 and 222

Architectural Record
October 1938, Page 46

Architectural Record
March 1940, Page 143

Architectural Record
August 1940, Page 68

Architectural Record
September 1941, Page 45

Architectural Forum
October 1942, Page 43

Architectural Record
November 1945, Page 60

Sweet's Catalogue Service, 1950

Architectural Sec. $\frac{6e}{5}$, Page 3

Items No. 373 and 379

Architectural Forum
July 1950, Page 75

Sweet's Catalogue Service, 1952 Architectural Sec. 6c, Page 14

Architectural Record
July 1952, Page 163

Railing in Main Staircase of Home Federal Savings & Loan Building, (now known as 202 S. State St. Building) Chicago, Illinois. William Sevic, 1718 S. Loomis St., Chicago, Illinois and Floyd A. Bolin, 1525 N. Kilpatrick Ave., Chicago, Illinois, have knowledge and information relating to this railing.

As to U. S. Letters Patent No. 2,905,445;

U. S. Letters Patent No. 163,996
Issued June 1, 1875 to P. J. Hardy

U. S. Letters Patent No. 837,769
Issued December 4, 1906 to H. Allen

U. S. Letters Patent No. 1,165,195
Issued December 21, 1915 to J. E. McNeil

U. S. Letters Patent No. 1,569,060
Issued January 12, 1926 to W. F. Wright

U. S. Letters Patent No. Reissue 17,629
Issued March 25, 1930 from an original Patent No. 1,658,956, issued February 14, 1928, to W. G. Wehr

U. S. Letters Patent No. 2,056,842
Issued October 6, 1936 to B. Edgecomb

U. S. Letters Patent No. 2,427,723
Issued September 23, 1947 to F. L. Hawkins and W. D. Phillips

U. S. Letters Patent No. 2,654,579
Issued October 6, 1953, to L. W. Cremens

U. S. Design Letters Patent No. 171,963
Issued April 20, 1954

Architectural Record
July 1934, Page 19

Architectural Forum
March 1937, Pages 219 and 222

Architectural Record
March 1940, Page 143

Architectural Record
September 1941, Page 45

Architectural Forum
October 1942, Page 43

Architectural Record
November 1945, Page 60

Sweet's Catalogue Service, 1950

Architectural Sec. $\frac{6e}{5}$, Page 3

Items No. 373 and 379

Blumcraft of Pittsburgh
Catalogues for years 1953, 1954 and 1955

Railing in Main Staircase of Home Federal Savings & Loan Building (now known as 202 S. State St. Building) Chicago, Illinois. William Sevic, 1718 S. Loomis St., Chicago, Illinois and Floyd A. Bolin, 1525 N. Kilpatrick Ave., Chicago, Illinois have knowledge and information relating to this railing.

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SUPPLEMENTAL NOTICE UNDER TITLE 35, UNITED STATES CODE, SECTION 282.

Now Come the Defendants, and in accordance with the provisions of Title 35, United States Code, Section 282, give notice that, at the trial of this action, the following patents, publications, and prior use and knowledge will be relied upon as anticipation of one or more of the patents in suit and showing the state of the art pertinent thereto, in addition to those previously noted:

U. S. Design Letters Patent No. 157,592
Issued March 7, 1950 to Peter R. Hollaender

U. S. Design Letters Patent No. 157,593
Issued March 7, 1950 to Peter R. Hollaender

U. S. Design Letters Patent No. 157,594
Issued March 7, 1950 to Peter R. Hollaender

Railing in Main Staircase of the building at 1010-1020 Broadway, Cincinnati, Ohio. Clarence Caeser, 5647 Lawndale Place, Cincinnati, Ohio; Peter R. Hollaender, 2206 Raeburn Drive, Cincinnati, Ohio; and Robert P. Hollaender, 5579 Meryton Lane, Cincinnati, Ohio, have knowledge and information relating to this railing.

Catalog of The Hollaender Manufacturing Company, 3841 Spring Grove Avenue, Cincinnati, Ohio, entitled "Nu-Rail Slip On Fittings" and bearing a copyright notice dated 1948, and including all pages thereof.

A brochure of The Hollaender Manufacturing Company, 3841 Spring Grove Avenue, Cincinnati, Ohio, having a first page comprising the letterhead of said company, and a second page referring to Nu-Rail Slip On Fittings, and bearing a printing identification date of October, 1949.

Catalog of The Hollaender Manufacturing Company, 3841 Spring Grove Avenue, Cincinnati, Ohio, entitled "Nu-Rail Slip On Fittings" and bearing a copyright notice dated 1952, and including all pages thereof.

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DONALD E. JOHNSON,
HOVEY, SCHMIDT, JOHNSON & HOVEY,
1816 Federal Reserve Bank Bldg.,
Kansas City, Missouri 64106,
Tel. No. VIctor 2-2459

ACKNOWLEDGMENT OF SERVICE.

Duplicate copies of the foregoing Supplemental Notice Under Title 35, United States Code, Section 282, acknowledged as served upon the undersigned, attorney for plaintiff, on this 17th day of December, 1964.

/s/ RALPH E. BAILEY, JR.,
Ralph E. Bailey, Jr.,
Broadus Avenue,
Greenville, South Carolina,
Attorney for Plaintiff.

SUPPLEMENTAL NOTICE UNDER TITLE 35, UNITED STATES CODE, SECTION 282.

NOW COME THE DEFENDANTS, and in accordance with the provisions of Title 35, United States Code, Section 282, give notice that the following publication will be relied upon in the defense of this suit as showing anticipation of the patents in suit and as showing the state of the art prior to the date of alleged invention of the structures of the respective patents:

Architectural Detailing, Caleb Hornbostel and Elmer A. Bennett, Reinhold Publishing Co., 1952 copyright, Pages 165 and 166 .

HAYNSWORTH, PERRY, BRYANT, MARION & JOHNSTONE,
By DONALD L. FERGUSON,
409 East North Street,
Greenville, South Carolina,
Tel. No. CEdar 3-3630,
Attorneys for Defendants.

Of Counsel:
WARREN N. WILLIAMS,
GORDON D. SCHMIDT,
HOVEY, SCHMIDT, JOHNSON & HOVEY,
1816 Federal Reserve Bank Bldg.,
Kansas City, Missouri 64106,
Tel. No. VIctor 2-2459.

UNITED STATES DEPARTMENT OF JUSTICE

WASHINGTON, D. C. 20530

Address Reply to the Division Indicated and Refer to Initials and Number

JWD:MTP:kld
154-38-63

January 26, 1965

James C. McConnon, Esquire
1815 Land Title Building
Broad Street
Philadelphia, Pennsylvania 19110

Re: Blumcraft v. United States
Court of Claims No. 38-63

Dear Mr. McConnon:

In response to your letter of January 21, 1965 in which you set forth a list of facts which you propose we agree to, we have the following to offer.

We can agree to the statements in paragraphs 1 and 2. However, paragraphs 3, 4 and 5 do not meet with our approval.

We propose that the following statement be added to the list of agreed facts:

6. Plaintiff Blumcraft has manufactured, commencing at least as early as January, 1958, and continues to manufacture railing components which plaintiff considers to be covered by the claim of Design Patent No. 171,963 here in suit.

We propose to enter the following documents in evidence on the issue of liability in addition to the prior art references cited in our answer:

1. U. S. Letters Patent No. 1,864,160
   Issued June 21, 1932 to R. G. Williams

2. Architectural Record
   April 1933, Page 269

3. Architectural Record
   July 1934, Page 19

4. Architectural Forum
March 1937, Pages 219 and 222

5. Architectural Record
October 1938, Page 46

6. Architectural Record
March 1940, Page 143

7. Architectural Record
August 1940, Page 68

8. Architectural Record
September 1941, Page 45

9. Architectural Forum
October 1942, Page 45

10. Architectural Record
November 1945, Page 60

11. Sweet's Catalogue Service, 1950
Architectural Sec. 6e/5 Page 3
Items No. 373 and 379

12. Architectural Forum
July 1950, Page 75

13. Sweet's Catalogue Service, 1952
Architectural Sec. 6c, Page 14

14. Architectural Record
July 1952, Page 163

We further plan to rely on the railing in the main staircase of the Home Federal Savings and Loan Building (now known as 202 South State Street Building), Chicago, Illinois as constituting prior use and knowledge.

We plan to oppose your Motion for Call and will file our response thereto in due course.

Yours very truly,

JOHN W. DOUGLAS
Assistant Attorney General
Civil Division

By: [signature]

T. Hayward Brown
Chief, Patent Section

Cc: Hon. Donald E. Lane
Commissioner
U. S. Court of Claims
Washington, D. C. 20005

UNITED STATES DEPARTMENT OF JUSTICE

WASHINGTON, D.C. 20530

Address Reply to the Division Indicated and Refer to Initials and Number

JWD:MTP:kw
154-38-63

August 6, 1965

James C. McConnon, Esquire
Paul & Paul
1815 Land Title Building
Philadelphia 10, Pennsylvania

Re: Blumcraft v. United States
Court of Claims No. 38-63

Dear Mr. McConnon:

Please take notice that in addition to the prior art set forth in our answer and that noted in the memorandum of pretrial conference filed January 27, 1965, we plan to rely on the following prior art at the trial of this case:

1. Publication of the Hollaender Manufacturing Co. entitled "Nu-Rail Slip-On Fittings" copyright 1952, 8 pages.

2. "Architectural Forum", October 1942, Page 43.

3. "Architectural Forum", March 1950, Page 100.

4. "Architectural Forum", June 1950, Page 127.

5. "Sweet's Catalogue Service", 1951, Architectural Section 6a/A, Page 21.

6. Aluminum in Architectural Work, London, Aluminum Union Limited 1940, 77 pages.

7. Architectural Detailing, Caleb Hornbostel and Elmer A. Bennett, Reinhold Publishing Co. 1952 copyright, Page 165 and Page 166.

8. Architect's Working Details, edited by D.A.C.A. Boyne, The Architectural Press 1953 in Great Britain, Page 60 and Page 61.

9. "New Pencil Points", January 1943, Page 24.

10. "Progressive Architecture", September 1948, Page 68 and Page 69, September 1948, Page 95.

11. "Progressive Architecture", November 1951, Page 26.

We plan to call as our expert witness James E. Francis of the General Services Administration, Washington, D. C.

Would you kindly forward at your earliest convenience copies of the drawing which you have stated represents the first conception of the patented railing in September of 1952. As we understand it from information which you have provided us, there is no documentary proof of the first alleged reduction to practice.

We are enclosing herewith the original reprint of what appears to be an excerpt from the 1952 Blumcraft Catalogue which you provided us. It is noted that although this publication bears a 1952 copyright notice it was never registered in the United States Copyright Office. Would you kindly inform us as to the first date on which this document was published.

Yours very truly,

JOHN W. DOUGLAS
Assistant Attorney General
Civil Division

By: T. Hayward Brown

T. Hayward Brown
Chief, Patent Section

Enclosure

Cc: Hon. Donald E. Lane
Commissioner
U. S. Court of Claims

IN THE

UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF SOUTH CAROLINA.

CIVIL ACTION NO. 4168.

BLUMCRAFT OF PITTSBURGH, A PARTNERSHIP CONSISTING OF HYMAN BLUM, MAX BLUM, LOUIS BLUM AND HARRY P. BLUM,

Plaintiff,

v.

CITIZENS & SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, AND DANIEL CONSTRUCTION COMPANY, INC.,

Defendants.

DEFENDANTS' SUPPLEMENTAL ANSWERS TO PLAINTIFF'S INTERROGATORIES NOS. 29 AND 31.

COME NOW THE DEFENDANTS, Citizens & Southern National Bank of South Carolina and Daniel Construction Company, Inc., through their attorneys, and as a supplement to their answers to the above identified interrogatories of plaintiff, state as follows:

Interrogatory No. 29—The attendance of Warren N. Williams at the trial of Civil Action No. 38-63 in the United States Court of Claims was not on the behalf of anyone. Architectural Art Mfg., Inc. paid for the time and expenses of such attendance.

Interrogatory No. 31—Defendants are not presently advised as to whether or not the subject item was published.

WARREN N. WILLIAMS,
Warren N. Williams,
HOVEY, SCHMIDT, JOHNSON & HOVEY,
1800 Federal Reserve Bank Bldg.,
Kansas City, Missouri 64106,
Tel. No. VIctor 2-2459.

Counsel for Defendants:
HAYNSWORTH, PERRY, BRYANT, MARION
& JOHNSTONE,
409 East North Street,
Greenville, South Carolina,
Tel. No. CEdar 3-3630.

ANALYSIS OF FINDINGS OF FACT.

The following are examples of findings of fact made by the District Court which were ignored or dismissed by the Court of Appeals for the Fourth Circuit:

Finding of Fact in District Court Opinion (Appendix page)	Treatment in Court of Appeals Opinion (Appendix page)
1. Definition of Blum design (9a): "a. A plurality of spaced parallel posts generally rectangular in cross section and arranged so as to present a series of spaced parallel vertical surfaces; "b. A plurality of spaced parallel hand rails generally flat or rectangular in cross section and arranged in the same vertical plane so as to present a series of parallel horizontal surfaces; "c. Connecting brackets attaching the underside of each handrail to the adjacent edge of each post, each bracket comprising a rod-like member extending at right angles to the post and a substantially flat triangu-	(47a): "The railing consists of multiple parallel rails offset from vertical posts. The handrails are generally flat with slightly curved gripping surfaces. The posts are rectangular. Inconspicuous L-shaped brackets attach the undersides of the rails to the posts, leaving the gripping surfaces of the rails unobstructed. The multiple, offset, and parallel handrails set up a horizontal plane in opposition to the vertical plane formed by the parallel posts. The result, with the connections between the two planes minimized, is the visual illusion that the handrails are floating free."

lar member extending upward from the rod-like member to the center of the underside of each rail leaving the rail unobstructed throughout the hand-gripping portion thereof;

"d. The aforesaid elements so designed and arranged as to cause the handrails to appear to float in space away from the posts."

2. Difficulty of producing design from prior art (12a):

"In fact considerable thought and a substantial redesign of the cited exhibits by the defendants would be necessary to achieve the design having the distinctive features of the Blum design."

(49a):

"It is apparent from the sophistication of the prior art that designers of ornamental railings, including manufacturers and architects, were highly skilled. Therefore, the fact, which the district court emphasized, that prior art would have to be redesigned to achieve Blum's railing is not decisive. The joining of known components usually requires skill, but this does not necessarily negate obviousness."

3. Hindsight (13a):

"But only through hindsight does the design ap-

No Mention.

pear obvious, which of course is not the test.''	
4. No reason to produce design (13a): ''There being no reason for the lower railings to be offset the design becomes more unobvious.	No Mention.
5. Design contrary to normal expectation and unusual (13a): Defendants' expert witness, ''Mr. Fishleigh, testified that plaintiff's design was contrary to the normal design in railings. He said 'it is contrary to what I would want any way. In other words, if I want a railing, I don't want one which is floating loose, kicking around; I want one which in my instance would give some degree of or indication of rigidity, that if I thought I got ahold of it, it would hold me.' The plaintiff's design is even more unusual in view of the normal expectation that a rail would and should appear very stable. Plaintiff's design is quite con-	No Mention.

trary to this in that it produces a floating effect, as opposed to an appearance giving stability."

6. Futile attempt by Respondents expert to duplicate Blum mechanical invention from prior art (23a-25a):

No Mention.

"The principal art relied upon by the defendants to invalidate Claim 1 of the mechanical patent is the Hardy Patent No. 163,996 and the 1954 Blumcraft Catalog reference. Defendants' witness Fishleigh through the use of these two references attempted to create a structure as defined by the plaintiff's claim . . . He developed an entirely new member to combine them, and then it was apparently through hindsight. His attempt to produce the structure vividly demonstrates the unlikelihood that anyone skilled in the ornamental railing art would attempt to do so."

7. Railroad track clamp not relevant to obviousness (25a):	(53a-54a):
"As to the McNeil Patent No. 1,165,193, heavily relied on by defendants, it cannot be used to invalidate plaintiff's patent. Although certain elements are the same McNeil was used as anti-creeping device for railroad tracks, something far removed from the art in which the present invention resides."	"The fact that McNeil's mechanism was designed to hold railroad rails and not handrails does not make his patent irrelevant. Both his mechanism and Blum's perform the same function: they stabilize a rail without interfering with the use of its upper surface. Because both are simple devices employing the same universally known principles of mechanics, McNeil's patent is pertinent prior art and supports our conclusion that Blum's device was obvious."
8. Spacing means integrated in clamping connection as new function (26a):	No Mention.
"It is significant that the spacing connector in the Blum patent also serves as the clamping means, and this a new function.	
9. Adjustability and rigidity (28a):	(53a):
"Although it was not new in the art to have a rail offset from the post,	"In addition, the unpatented device Blum originally used in railings manufactured

it was novel to have the Blum type of connector for attaching the rail so as to give adjustability to the particular need and rigidity as is required for railings.

"One of the most important features of the mechanical patent is the flexibility allowed in combination with rigidity. The rail portion can be adjusted when the clamping members are loose and may be moved, whereas when tightened they are completely rigid. Although the defendants attack the validity of the patent with numerous exhibits, particularly the Hardy and McNeil Patents, the court finds that none of the prior art shows this type of mechanical arrangement."

from his design patent disclosed the flexibility plus rigidity that the district court found unique to Blum's later mechanism."

IN THE

UNITED STATES COURT OF CLAIMS.

No. 38-63.

BLUMCRAFT OF PITTSBURGH,

Plaintiff,

v.

THE UNITED STATES,

Defendant.

SUPPLEMENT TO MOTION TO QUASH SUBPOENA DUCES TECUM.

COMES NOW WENZEL W. THOM, President of Architectural Art Mfg., Inc., Wichita, Kansas, and through his attorney, now moves the Commissioner under the provisions of Rule 51(c) of the Rules of the United States Court of Claims for a Final Order quashing the subpoena including the duces tecum part thereof, dated January 27, 1969 and served on Wenzel W. Thom February 6, 1969. This supplement to the original motion is made on the grounds that it is unreasonable and oppressive to permit plaintiff to continue its efforts to search through all of the records of Architectural Art Mfg., Inc. for the period specified in the subpoena, especially in light of the facts developed during the preliminary inspection made by counsel for plaintiff in the presence of the Commissioner on February 18, 1969, and in view of the decision of the United States Court of Appeals for the Fourth Circuit on February 19, 1969, holding Design Patent No. D-171,963 invalid and unenforceable against Architectural Art Mfg., Inc.

Wenzel W. Thom appeared before the Commissioner at 10:00 A. M. on February 18, 1969, pursuant to the subpoena of January 27, 1969, but counsel for plaintiff elected not to take his testimony at the scheduled time and instead decided to make a preliminary inspection of the records of Architectural Art Mfg., Inc. under an oral protective order by the Commissioner. No testimony was taken of Wenzel W. Thom on February 18, 1969, notwithstanding his availability throughout the entire day.

The preliminary inspection by counsel for plaintiff of the records of Architectural Art Mfg., Inc., including those referred to in the motion to quash mailed on February 11, 1969, tended to establish that Architectural Art Mfg., Inc. had not in fact sold significant quantities of railings to the Government if at all within the period of January 1, 1960 to December 31, 1966. In addition, it was clear that if any sales of railings accused to infringe Patent No. D-171,963 had in fact occurred, damages on the dollar amount thereof would obviously be *de minimis* in comparison with the cost of making a conclusive search through all of the records and files of Architectural Art Mfg., Inc. to confirm whether or not even small quantities of such railings had in fact been sold to the United States in the specified period. Plaintiff resolutely refuses to compensate Architectural Art Mfg., Inc. and its officers for the time that would necessarily be spent in either making the inspection of records sought by plaintiff, or assisting counsel for plaintiff with his inspection thereof, and it is clearly unreasonable and oppressive to require Architectural Art Mfg., Inc. to make its records available under the mandate of the subpoena. Noteworthy in this connection is the plaintiff's failure to cite even one instance of a Government sale or acknowledgment by the United States that it purchased quantities of the accused railing structure during the period of January 1, 1960 to December 31, 1966.

The reasons initially advanced in support of an Order to quash are reaffirmed and incorporated herein by reference.

Additionally, in a decision dated February 19, 1969, the United States Court of Appeals for the Fourth Circuit held Patent No. D-171,963 invalid in an action where Blumcraft alleged the patent to be of a scope to cover the products of Architectural Art Mfg., Inc. and still define patentably over the prior art. (A copy of the decision is annexed hereto.) Accordingly, it is submitted that no railing structures manufactured and sold by Architectural Art Mfg., Inc. to the Government or anyone else can validly be considered to come within the Design Patent.

For the foregoing reasons, it is asked that the Commissioner's preliminary ruling on the motion by Wenzel W. Thom to quash the subpoena, wherein it was Ordered that the subpoena was squashed subject to an agreement between counsel as to the procedures to be carried out for effecting the inspection of the records of Architectural Art Mfg., Inc., be supplanted by a Final Order quashing the subpoena in its entirety.

Respectfully submitted,

WM. F. PIELSTICKER,
Wm. F. Pielsticker,
1400 Wichita Plaza Building,
Wichita, Kansas 67202
Tele.: (316) AM 7-0235,
Attorney for Wenzel W. Thom.

CERTIFICATE OF SERVICE.

I hereby certify that on this 27th day of February, 1969, I sent two (2) copies of the foregoing Supplement To Motion To Quash Subpoena Duces Tecum to Commissioner Lane, United States Court of Claims, Washington, D. C., one (1) copy to Nick Kalokahlis, United States Department of Justice, Civil Division, Patent Section, Washington, D. C., and one (1) copy to James C. McConnon, Paul & Paul, 1815 Land Title Building, Philadelphia, Pennsylvania 19110, by first class mail, postage prepaid.

WM. F. PIELSTICKER.
Wm. F. Pielsticker.

EXHIBIT G TO ANSWER TO INTERROGATORY 26.

August 13, 1965
AIR MAIL—REGISTERED LETTER

United States Department of Justice
Washington, D. C. 20530
Attention: Michael Platt
Patent Section
Re: *Blum Depositions*

Dear Mike:

Enclosed are copies of the Blum depositions which you requested. It is understood that these copies will be returned as soon as you have concluded your review thereof.

Also, I understand that you plan to obtain certified copies of all depositions which you plan to introduce, from the court in South Carolina. This will avoid any necessity of your referring to direct collaboration with us in this suit and which we prefer.

Yours very truly,

HOVEY, SCHMIDT, JOHNSON & HOVEY,
By

WNW:ef
Encls.